

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARTIN HAUPT,
FRANZ KLETZL, and ROBERT NEMETH

Appeal 2006-3361
Application 09/090,035
Technology Center 2100

Decided: September 7, 2007

Before JOSEPH L. DIXON, JOHN A. JEFFERY, and SCOTT R. BOALICK,
Administrative Patent Judges.

DIXON, *Administrative Patent Judge.*

ORDER REMANDING TO THE EXAMINER

This is an Order to Appellants and remanding the application to the Examiner to consider Appellants' response and to respond as appropriate. From our initial review of the application and prosecution history, we note Appellants main contention is with respect to the:

transport means for transporting the information discs from the eject position into a loading position along a curve-shaped loading path, the loading position being a position for loading discs from the loading path of the transport means into the stacking positions of the stacking unit; and in which the play position is along the loading path between the eject position and the loading position.

(Claim 1) [Emphasis added.]. Here, we find no identification in the Brief or the Reply Brief as to the corresponding structure, acts, or materials of the means plus function limitation. While the present rule for filing an Appeal Brief (37 CFR § 41.37) specifically requires identification of the correspondence of the “means” limitations to the disclosed invention, the prior rule did not require such a description in the Summary of the Claimed Invention. We find it necessary and prudent to have Appellants identify what they understand to be the corresponding structure, acts, or materials, from the originally filed specification, for the recited “transport means for transporting the information discs from the eject position into a loading position along a curve-shaped loading path” as recited in independent claims 1 and 21. With the claims interpreted in the proper context, we will be better able to make an informed evaluation of the prior art in a comparison to the properly interpreted structure of independent claims 1 and 21. Pursuant to 37 CFR § 41.50(d) “The Board may order appellant to additionally brief any matter that the Board considers to be of assistance in reaching a reasoned decision on the pending appeal. Appellant will be given a non-extendable

time period within which to respond to such an order. Failure to timely comply with the order may result in the sua sponte dismissal of the appeal.”

Upon review and consideration of Appellants’ correlation of the “transport means” to the disclosed subject matter, the Examiner may submit a Supplemental Examiner’s Answer specifically addressing the corresponding subject matter and claim interpretation.

Accordingly, it is ORDERED that the application is returned to the Examiner:

- (1) Appellants must within one (1) month provide the Examiner with the description of the corresponding structure, acts, or material as described in the Specification for the “transport means” pursuant to 35 U.S.C. § 112, sixth paragraph and any corresponding embellishing discussion deemed appropriate thereto;
- (2) the application is returned to the Examiner to await Appellants’ description of the corresponding structure, acts or material as described in the Specification for the “transport means” pursuant to 35 U.S.C. § 112, sixth paragraph;
- (3) the Examiner is to review Appellants' correlation and to provide a Supplemental Examiner’s Answer as deemed appropriate and necessary; and
- (4) for such further action as may be appropriate.

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